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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/732,928	12/10/2003	Peter Czerncy	OEH-001	7361

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EXAMINER

POWERS, FIONA

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 09/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

### Application No.

10/732,928

### Applicant(s)

CZERNEY ET AL.

### Examiner

Fiona T. Powers

### Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-7 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

Receipt is acknowledged of the preliminary amendments filed February 19, 2004, 'April 5, 2004 and August 11, 2004, which have been entered in the file.

Claim4 is objected to because of the following informalities: a period appears in the middle of the claim. The period should be placed after the formulas. Appropriate correction is required.

Claims 3 to 6 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should depend on other claims in the alternative only. See MPEP § 608.01(n). Accordingly, the claims 3 to 6 have not been further treated on the merits.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 provides for the use of hydrophil markers, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is

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intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 5 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim 6 recites the limitation "complexes" in line 3. There is insufficient antecedent basis for this limitation in the claim. To overcome this rejection "complexes" should be replaced by -hydrophil markers-.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1 to 3 and 5 to 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Czerney et al. (Biol. Chem., 382(3), 495-498, 2001), cited.

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The reference discloses the claimed hydrophil marker of the formula II wherein n is 1, R<sup>1</sup>, R<sup>4</sup>, R<sup>5</sup>, R<sup>7</sup>, R<sup>8</sup>, R<sup>9</sup> and R<sup>12</sup> are hydrogen, R<sup>2</sup> and R<sup>3</sup> are ethyl, R<sup>6</sup> is t-butyl, R<sup>13</sup> and R<sup>14</sup> are methyl, R<sup>11</sup> is SO<sub>3</sub><sup>-</sup> and R<sup>10</sup> is a reactive group which is N-hydroxysuccinimide ester which is linked to the chromophore by the aliphatic spacer group (CH<sub>2</sub>)<sub>5</sub> or R<sup>10</sup> is CO<sub>2</sub>H which is linked to the chromophore by an aliphatic spacer group (CH<sub>2</sub>)<sub>5</sub>. The marker dyes are used in the optical determination of proteins, nucleic acids, DNA, biological cells, lipids, pharmaceuticals and/or polymers. The references also disclose the claimed systems. Note DY-630 in Figure 1, page 497 left-hand side second paragraph to right-hand side second paragraph of Czerney et al. (Biol. Chem., 382(3), 495-498, 2001); and Figure 3, Examples 3, 7 and 10 and paragraphs [0019] to [0022] of Czerney et al. 2002/0115862.

Claims 1 to 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Okada (US 6143434), cited.

The reference discloses the claimed hydrophil marker of the formula I wherein n is 0, R<sup>2</sup> and R<sup>3</sup> are ethyl, R<sup>6</sup>, R<sup>10</sup>, R<sup>13</sup>, and R<sup>14</sup> are methyl and R<sup>1</sup>, R<sup>4</sup>, R<sup>5</sup>, R<sup>7</sup>, R<sup>8</sup>, R<sup>9</sup>, R<sup>11</sup> and R<sup>12</sup> are hydrogen. Note Compound No. 26 in column 14.

Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fiona T. Powers whose telephone number is (571)272-0702. The examiner can normally be reached on Monday - Friday 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on (571)272-0699. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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*Fiona T. Powers*

Fiona T. Powers  
Primary Examiner  
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September 17, 2004